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| 10/651,387 | 08/29/2003 | Ken Hamilton | HAMK-26,430 | 9246 |
| 25883 | 7590 | 09/16/2010 | EXAMINER | |
| HOWISON & ARNOTT, L.L.P | | | NGUYEN, TAN D | |
| P.O. BOX 741715 | | | | |
| DALLAS, TX 75374-1715 | | | | |
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| | | | 3689 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@dalpat.com

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/651,387 | HAMILTON, KEN | |
| | Examiner | Art Unit | |
| | Tan Dean D. Nguyen | 3689 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-14 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-14 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment of 5/14/2010 has been entered. Claims 1-4, 6, 7, 9-10, 12-14, 17-19, 21, 22, and 23 have been amended. Claim 8, 15-16 have been canceled.

Claim Status

Claims 1-7, 9-14, 17-23 are pending. They comprise of 4 groups:

- 1) system: 1-7, 9-11,
- 2) method: 12, 13-14, 17-21,
- 3), system: 22, and
- 4) method: 23.

Claims canceled: 8, 15-16.

As of 5/14/2010, claim 1 is as followed:

1. (Currently Amended) A decision analysis system comprising:
 - a) a first decision group server;
 - b) a decision tool component including a model base communicably connected to the first decision group server, including models representing multi-criteria decision analysis and Bayesian analysis techniques;wherein upon receiving a decision task, the first decision group server organizes the decision analysis process for the decision task by identifying decision analysis components and where said first decision group server selects one or more appropriate models from the model base for each decision analysis component.

12. (Currently Amended) A method of performing decision analysis comprising the steps of:

- a) defining a decision for decision analysis;
- b) assigning an expert to a first decision group;
- c) organizing the decision analysis into decision components;
- d) communicating a decision components to a first decision group;
- e) selecting one or more models from a model base by the first decision group,

the model base including models representing multi-criteria decision analysis and Bayesian analysis techniques;

f) applying the selected model by the expert assigned to the first decision group to produce decision analysis results;

g) reporting the decision analysis results;

h) aggregating the decision analysis results to generate aggregated decision analysis results; and

i) reporting the aggregated decision analysis results to the first decision group.

Note: for convenience, letters (a)-(i) are added to the beginning of each step.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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3. Claims 12-14, 17-21 (method) and 23 (method) are rejected under 35 U.S.C.

101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must:

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(a) To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

(b) There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

(c) Here, applicant's method steps fail the first prong of the new test because there is no tie to a machine or apparatus.

(d) Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

Principles of Laws

4. 1) Claims 1 -7, 9-11 and 22 are an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, or **steps**, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Therefore, in claim 1, the phrase "wherein upon receiving a decision task, ...organizes... by identifying selects...", etc., are considered as steps or manner of operating the devices, thus carrying no patentable weight in an apparatus claim. In

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Claim 22, the “wherein clause”, has the same issues as shown in claim 1 above, thus appear to have no patentable weight in an apparatus claim.

Claim Rejections - 35 USC § 112

5. Claims 1-7, 9-11 (system), 12-14, 17-21 (method), 22 (system) and 23 (method) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In independent claims 1 and 22, the claim contain many method steps which make the claim vague and indefinite because the limitations of the “method steps” appear to be critical to the apparatus and it's not clear how the apparatus can function without the structures of the limitations in the steps. Converting the limitations in the steps to positive structures are recommended to overcome the rejections.

2) In claims 12 and 23, the step of “applying the selected model ...to produce decision analysis results” is vague and indefinite because it's not clear what feature or element has been applied by the selected model to produce the analysis results. In other word, the model has to receive input or information or data for it to work or carrying out the modeling. There is no citation of “inputting information into the model” limitation.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-7, 9-11, 12-14, 17-23 are rejected under 35 U.S.C. 103(a) as obvious over (1) MCDM Article, "Excellent for Service Level, Change and Risk Management", hereinafter as "MCDM Article", and (2) Article "Making Decisions: Using Bayesian Nets and MCDA", April 2000, hereinafter as "BBM Article", or vice versa.

As for claims 1, 12, 22 and 23, MCDM Article, wherein MCDM appear to be the abbreviation of "Multiple-Criteria Decision-Making", discloses a method of performing decision analysis comprising the steps of:

(a) defining a decision for decision analysis; {see page 2, 1st paragraph}

b) assigning an expert to a first decision group;

{see page 2, section 4.3, page 3, section 4.3.2.}

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c) organizing the decision analysis into decision components; {see page 2, section 4.3}

d) communicating a decision components to a first decision group; {see page 2, 1st paragraph, page 3}

e) selecting one or more models from a model base by the first decision group;

{see page 2 and page 3}

f) applying the selected model by the expert assigned to the first decision group;

{see pages 2-3}

g) reporting decision analysis results; {see page 2, 1st full paragraph, page 3}

(h) aggregating decision analysis results to generate aggregated decision analysis results;

{see page 1}

(i) reporting the aggregated decision analysis results to the first decision group.

{see pages 2-3}.

Alternatively, the use of the "Multiple-Criteria Decision-Making" model for other business decision would have been obvious as mere applying the same model to other business application in view of the teachings of multiple business applications on pages 5-16.

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MCDM Article fairly teaches the claimed invention except for the limitation of “Bayesian analysis techniques” in the model.

In a similar system/method for making decisions, **BBM Article** teaches the use of Bayesian analysis techniques or Bayesian Belief Nets (BBNs) as an extremely powerful technique for reasoning under uncertainty and predicting properties of critical systems. BBM Article also discloses that in many circumstances, the decisions should be made based on multiple criteria and the BBN must be complemented by other decisions making techniques such as those of multi-criteria decision aid (MCDA) {see abstract, pages 3-48-12}. Therefore, it would have been obvious to modify the teachings of MCDM Article to include the teachings of BBM Article under circumstances wherein the decisions should be made based on multiple criteria and the BBN must be complemented by other decisions making techniques such as those of multi-criteria decision aid (MCDA).

Alternatively, the teachings of BBM Article is cited above. It would have been obvious to modify the teachings of BBM Article to include the specific steps of making decisions as taught by MCDM Article above to meet desired analysis.

Note that on page 4 of MCDM Article, it discloses the set up of the application on the **Internet or World Wide Web**, therefore, the use of a server (computer) to carryout the operation on the Internet is conventional or set up a server system would have been obvious to a skilled artisan for operating on the Internet.

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As for dep. claims 2-7, 9-11 (part of 1 above) which deal with well known interactions between the different groups on the Internet/server, these are taught in MCDM Article as shown on pages 2-6, 14-16 in view of the web server.

As for dep. claims and 13-14, 17-21 (part of 12 above), which deal with well known interactions between the different groups on the Internet/server, these are taught in MCDM Article as shown on pages 2-6, 14-16 in view of the web server and BBM Article pages 5-15.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. 1) US 2001/0 032 092, by Calver, discloses a business decision analysis in an Internet using server and would have been obvious to include in the teachings of MCDM Article /BBM Article above.

No claims are allowed.

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1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).
2. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
3. Any response to this action should be mailed to:
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Hand delivered responses should be brought to the
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4. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.
5. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689